

AUG 10 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Chellapa Balan

Serial No.: 10/064,829

Filed: August 21, 2002

For: IMPROVED FLUID PASSAGES FOR
POWER GENERATION EQUIPMENT§
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Group Art Unit: 1745

Examiner: Dove, Tracy Mae

Atty. Docket: 124719-1/YOD
GERD:0458**Via Facsimile: (571) 273-8300**

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August 10, 2005
Date
Lynda Howell**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Appellant respectfully requests review of the Final Rejection in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

The application includes claims 1-14, of which claims 1 and 7 are independent. The Examiner initially and finally rejected all of the pending claims on a sole basis. That is, all claims stand rejected under 35 U.S.C. §112, first paragraph for failing to comply with the enablement requirement. In response to the Final Office Action, an amendment was filed altering the terms of claims 7, 8, 9 and 12. However, in the Advisory Action mailed on July 26, 2005, the Examiner indicated that the amendment had not been entered. Accordingly, the Appellant respectfully requests that the present review be conducted based upon the original claims.

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Independent claim 1 recites a cooling apparatus for fuel cell components. The apparatus includes a baseplate and a plurality of upper ribs and lower ribs. Particular configurations for the ribs and channels formed by the ribs are defined by the claim. Independent claim 7 recites a fuel cell assembly that comprises at least one fuel cell and at least one cooling apparatus. The cooling apparatus definition includes recitations generally identical to those of claim 1.

In the initial and Final Office Actions, the Examiner stated that the specification did not describe the claimed subject matter in such a way as to enable one skilled in the pertinent art to make and/or use the invention. Specifically, the Examiner pointed to the fact that reference is made in the specification to a repeatable fuel cell unit. The Examiner continued by pointing out that in an actual fuel cell, without more elements than those recited in the claims and described in the specification, oxidant and fuel would contact both anode and cathode surfaces.

Appellant pointed out in both Responses, and renews for this review, his position that the claims do not relate to a fuel cell stack. Indeed, independent claim 1 specifically recites *only a cooling apparatus*. Appellant further pointed out that one skilled in the art would readily recognize that an actual fuel cell stack could, and even would include other components, such as a separator plate, not specifically disclosed in the application.

It is Appellant's position that the specification need only enable the claimed subject matter. To the extent that independent claim 1 and its dependent claims relate only to a cooling apparatus, there is no requirement whatsoever that each and every functional element of a working fuel cell be specified or described. Similarly, to the extent that independent claim 7 and its dependent claims recites "at least one fuel cell," the specification is entirely sufficient.

Appellant pointed out in the Response to the Final Office Action that it was relatively whether the Examiner intended to reject the claims as reciting inoperative subject matter (e.g., under MPEP §2164.08(b)) or because a critical feature was considered to be missing from the claims (e.g., under MPEP §2164.08(c)). Appellant submits that, under both of these sections, the

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claimed subject matter is commensurate in scope with the specification and vice versa. That is, the specific subject matter recited in independent claims 1 and 7 is fully operative *per se* given the limitations inherent in the claim language. Similarly, given the scope of these claims, any type of separator (and indeed all other required components of a functioning fuel cell) do not constitute critical features missing from the claims.

In summary, it is Appellant's position that in the present case, many other components *could and would* be included in an actual fuel cell product. However, nothing in the Patent Statute, Rules or the MPEP requires that a claim recite all elements that would eventually be included in a manufactured product. The claims are not a blue print for a commercial product. In the present case, extraneous, unclaimed elements are not critical and are irrelevant to *the invention claimed*. As such, a rejection for lack of enablement or inoperability is improper.

For the above reasons, Appellant respectfully requests review of the Final Rejection prior to filing of an Appeal Brief in the present application.

Respectfully submitted,

Date: 8/10/2005

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